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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/148,723	09/03/1998	WARREN M. FARNWORTH	MI22-981	3884
21567	7590	11/05/2004		
WELLS ST. JOHN P.S. 601 W. FIRST AVENUE, SUITE 1300 SPOKANE, WA 99201				
			EXAMINER TUGBANG, ANTHONY D	
			ART UNIT 3729	PAPER NUMBER

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/148,723

Applicant(s)

FARNWORTH ET AL.

Examiner

A. Dexter Tugbang

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,6,8,11,13,20,22,23,26,27,30,31,36,37,45 and 48-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,23,26,27,30,31,36,37,45 and 48-53 is/are allowed.
- 6) ☒ Claim(s) 3,6,8,11,13,20,22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/2/04 has been entered.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 3, 6, 8, 11, 13, 20 and 22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 6, 8, 11, 12, 18 and 20 of copending Application No. 10/004,172 in view of PCT Publication WO 98/12738, referred to hereinafter as WO'738.

Regarding Claims 3, 6, 8 and 11 of the instant application, these limitations are met substantially by the limitations of Claims 12, 6, 8 and 11 of copending Application No. 10/004,172 with the exception of the absence of flux when bonding the balls.

Regarding Claims 13, 20 and 22 of the instant application, these limitations are met substantially by the limitations of Claims 18 and 20 of copending Application No. 10/004,172 with the exception of the absence of flux when bonding the balls and moving the frame to proximate the substrate before any of the of balls are delivered into the holes.

WO'738 teaches a bonding process including: 1) providing both a fluxless bonding surface, i.e. the absence of flux (see page 5); and 2) moving a frame 18 (in Fig. 1) with a plurality of holes 22 to proximate a substrate 10 before any balls 24 are delivered into the holes 22. The benefits of the above bonding process accurately place the balls of solder on the substrate through the use of the frame and effect bonding conditions within a continuous manufacturing process at various stations (as shown in Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the claims of copending Application No. 09/148,723 by utilizing the bonding process taught by WO'738, to advantageously provide the benefits of placing the balls of solder on the substrate through the use of the frame and effect bonding conditions within a continuous manufacturing process at various stations.

This is a provisional obviousness-type double patenting rejection.

***Terminal Disclaimer***

4. The terminal disclaimer filed on 9/2/04 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of application 10/004,172 has been reviewed and is NOT accepted for the reasons set forth below.

The terminal disclaimer does not provide acceptable language for making the disclaimer of the terminal portion of the pending application. See example I below. Accordingly, the Double Patent rejection above continues to be maintained.

Examples of acceptable language for making the disclaimer of the terminal portion of any patent granted on the subject application follow:

I. If a Provisional Obviousness-Type Double Patenting Rejection Over A Pending Application was made, use:

Petitioner hereby disclaims, except as provided below, the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of any patent granted on Application No. \_\_\_\_/\_\_\_\_\_, filed on \_\_\_\_\_, as shortened by any terminal disclaimer. Petitioner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the above-listed application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors, or assigns.

II. If an Obviousness-Type Double Patenting Rejection Over A Prior Patent was made, use:

Petitioner hereby disclaims, except as provided below, the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of Patent No. \_\_\_\_\_, as presently shortened by any terminal disclaimer. Petitioner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the above listed patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors, or assigns.

Alternatively, Form PTO/SB/25 may be used for situation I, and Form PTO/SB/26 may be used for situation II; a copy of each form may be found at the end MPEP Chapter 1400.

***Allowable Subject Matter***

5. Claims 1, 2, 23, 26, 27, 30, 31, 36, 37, 45 and 48-53 are allowed.

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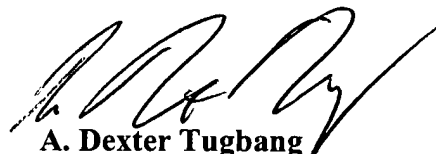
***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 703-308-7599.

The examiner can normally be reached on Monday - Friday 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**A. Dexter Tugbang**  
**Primary Examiner**  
**Art Unit 3729**

November 1, 2004